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REMARKS

Claims 40-47 are pending in the subject application. By this Amendment, applicants have amended claim 40 to indicate the ATCC Accession No. for the deposited PA-6 and PA-7 hybridomas. Applicants note that these amendments are supported by the amendments to the specification described above, and maintain that the amendments to the specification and to claim 40 do not raise any issue of new matter. Accordingly, applicants respectfully request that the Examiner enter this Amendment. Upon entry of this Amendment, claims 40-47, as amended, will be pending and under examination.

Applicants again thank the Examiner for the courtesy extended during the interview held on December 7, 2004, a Summary of which was prepared by the Examiner on December 7, 2004 and a Communication providing a more detailed summary of which was filed by applicants on January 4, 2005. Applicants also thank the Examiner for re-mailing the present March 21, 2005 Office Action after an electronic copy of an Office Action dated December 29, 2004 was posted on the Patent Office's public PAIR site but the actual Office Action was never received by applicants in the mail. Applicants note that in an Interview Summary accompanying the March 21, 2005 Office Action, the Examiner stated that the response period is reset to commence from the mailing date of this Office Action.

Rejections under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 40-47 under 35 U.S.C. 112, first paragraph, on the ground that the specification allegedly fails to provide an enabling disclosure for the claimed invention. The Examiner stated that it is apparent that the monoclonal antibodies PA-6 and PA-7 are required to practice the claimed invention. The Examiner also stated that as required elements, they must be known

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and readily available to the public or obtainable by a repeatable method set forth in the specification. The Examiner further stated that if they are not so obtainable or available, the enablement requirements of 35 U.S.C. §112, first paragraph, may be satisfied by a deposit of the hybridoma cell line producing said antibodies (citing 37 C.F.R. §1.302).

The Examiner stated that due to the unpredictability associated with antibody production (i.e. each antibody generally has a unique structure) and the failure of the specification to provide any detailed structural information concerning the claimed antibodies, MAbs PA-6 and PA-7 do not appear to be readily available materials. The Examiner further stated that deposit of the hybridoma cell lines producing said antibodies or detailed structural information (i.e. the complete nucleotide or amino acid sequence of each antibody) would satisfy the enablement requirement of 35 U.S.C. §112. The Examiner also stated that if a deposit is made under the terms of the Budapest Treaty, an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty, and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements (citing 37 C.F.R. §1.808).

The Examiner further specified criteria that must be satisfied if the deposits have been made at an acceptable depository but not under the provisions of the Budapest Treaty.

In response, applicants affirm that hybridomas, PA-6 and PA-7, secreting the PA-6 and PA-7 monoclonal antibodies, respectively, were deposited on March 24, 2005, pursuant to the Budapest Treaty, with the Patent Culture Depository of the American Type Culture

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Collection (ATCC) under ATCC Accession Nos. PTA-6637 (PA-6) and PTA-6638 (PA-7), respectively. For the Examiner's convenience, applicants attach hereto as Exhibit A a copy of the April 8, 2005 Budapest Treaty Deposit Receipt and Viability Statement for the PA-6 and PA-7 hybridomas. Applicants note also that claim 40 has been amended herein to indicate the ATCC Accession No. for these hybridomas.

In accordance with 37 C.F.R. §1.804(b), applicants attach hereto as Exhibit B a Declaration under 37 C.F.R. §1.132 by William C. Olson, Ph.D., Vice President (Research and Development) of Progenics Pharmaceuticals, Inc. to which the subject application is assigned, corroborating that although the original deposit of the PA-6 and PA-7 hybridomas was made after the filing date of the subject application, the biological materials deposited are the same biological materials specifically identified as PA-6 and PA-7 in the application as filed.

Consistent with the requirements of 37 C.F.R. §1.808, and subject to paragraph (b) of §1.808, applicants' undersigned attorney states that the deposit of the PA-6 and PA-7 hybridomas was made under the terms of the Budapest Treaty, and that all restrictions on the availability to the public of the materials deposited under ATCC Nos. PTA-6637 and PTA-6638 will be irrevocably removed upon the granting of a patent from the subject application.

In view of the foregoing, applicants request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §112, first paragraph.

Amendment of the Specification

The Examiner also stated that the identifying information set forth in 37 C.F.R. §1.809(d) should be added to the specification (referring applicants to 37 C.F.R. §§ 1.803-1.809 for additional

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explanation of these requirements).

In response, applicants note that the specification has been amended hereinabove in conformance with the Examiner's request. In accordance with 37 C.F.R. §1.809(d), the specification, as amended, provides the ATCC Accession Nos. for the deposits, the date of the deposits, a description of the deposited hybridomas sufficient to specifically identify them and to permit examination, and the name and address of the ATCC depository.

Examiner's Response to Applicants' Arguments

The Examiner stated that the arguments made by applicants in their Amendment filed March 29, 2004, and the declaration(s) referenced therein, were carefully considered and were considered to be persuasive as directed toward the rejections set forth in the last Office action.

In response, and in view of the remarks presented hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the claim rejections set forth in the March 21, 2004 Office Action, and allow pending claims 40-47, as amended.